REMARKS / ARGUMENTS

Remaining Claims

Twenty-five (25) claims (Claims 1 and 3 – 22) remain pending in this application through this Amendment. Claims 1, 8, 11, 14, and 17 have been amended to more clearly define the invention; and Claims 43 – 49 are added.

As explained in more detail below, Applicants submit that all claims are in condition for allowance and respectfully request such action.

Rejection of Claims 1 - 22 under 35 USC §103(a) – Japanese Kokai in view of Hoffman, et al.

Claims 1 – 22 stand rejected under 35 USC §103(a) as being obvious under Japanese Kokai 1-152,015 (JP '015)in view of US Patent No. 5,607,518 to *Hoffman, et al.*

Claims 1, 8, 11, 14, and 17 have been amended to specify that the temperature of the entire contact lens is lowered to a point at which the lens will separate from the mold without damage.

New Claims 43 – 49 require that the temperature of the lens be lowered to a "temperature at which the lens will release from the mold *without the application of external force to the lens.*"

Applicants respectfully submit that neither JP '015 nor *Hoffman, et al.*, singly or in combination, disclose or suggest "lowering the temperature of the *entire* contact lens with a cryogenic substance." Nor do they disclose or suggest lowering the temperature of the contact lens such that "the lens will release from the mold *without the application of external force to the lens.*"

Specifically, while JP '015 does teach quenching of a recently formed lens having "recessed and projected sections on its surface" (e.g. fresnel lens) with a cryogen, it explicitly teaches that the "lower surface 3b adhered to the mold retains the mold temperature" and that the lens is ejected from the mold with "ejecting pins 5 and 6." Any loosening of the lens within the mold is due to a "large local shrinkage 17 ... generated on the upper surface" – and not to the cooling of the entire contact lens. Furthermore, the use of the ejecting pins demonstrates that the lens will not "release from the mold *without the application of external force to the lens.*"

Furthermore, *Hoffman, et al*, fails to teach "lowering the temperature of the contact lens with a cryogenic substance to a temperature sufficient to reduce adhesion between the lens and the mold." While *Hoffman, et al.* do teach immersion of the contact lens into a supercritical fluid (SCF), for a SCF to achieve the objectives of the process defined therein, it must have a "temperature of at least 20 °C and a pressure of at least 600 psia." (Col. 3, lines 39 – 45). Such a fluid is certainly not within the scope of a cryogen, as claimed. In fact, no example teaches a temperature below 25 °C and no example carried out at a temperature below 30 °C achieved anything but partial and incomplete deblocking[1]. Thus, *Hoffman, et al.* do not teach *use of cryogenic* in order to reduce adhesion.

Therefore, since the cited combination of prior art does not fairly teach or suggest the claimed invention, the claims, as amended, are not rendered obvious by JP '015 in view of *Hoffman, et al.*. Applicants, therefore, respectfully request that this rejection be withdrawn.

CONCLUSION

In view of the foregoing and in conclusion, Applicants submit that the 35 USC §103 rejection set-forth in the Office Action have been overcome, and that the pending claims are not indefinite or obvious over the cited art, either individually or in combination. Applicants request reconsideration and withdrawal of the rejection(s) set-forth in the Office Action. Should the Examiner believe that a discussion with Applicants' representative would further the prosecution of this application, the Examiner is respectfully invited to contact the undersigned.

Respectfully submitted,

Robert J. Gorman, Jr.
Reg. No. 41,789
(678) 415.4389

CIBA Vision Corporation
11460 Johns Creek Parkway
Duluth, GA 33097

g:\busunits\legal\public\patents\prosecut\31174\a\amendment b.doc

[1] While Example VIII teaches a temperature of "about 21 °C," it is important to note that this example does not use a SCF, but instead, is a control sample utilizing 100% IPA to extract the lenses after they are deblocked. Thus, *Hoffman, et al.* teach using higher temperatures than has been used in the art (i.e., the control).